

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

In the specification, applicants amend paragraphs on pages 1, 7, 8 and 37 to address the PTO's objections. Support for the amendment is found, e.g., in the as filed application on page 46, lines 2-7, page 43, lines 20-24, page 7, lines 9-13 and 16-19, page 10, lines 6-20, and page 49, lines 8-12. No new matter is introduced.

Applicants cancel claims 3-39 without prejudice or disclaimer.

Applicants amend claims 1-2 to present the invention more clearly and to address the PTO's rejections/objections. Support for the amendment is found, e.g., in the as-filed specification on page 46, lines 2-7, page 43, lines 20-24, page 7, lines 9-13 and 16-19, page 10, lines 6-20, and page 49, lines 8-12. No new matter is added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-2 are now pending in this application.

PRIORITY DATE

Applicants point out that the present application is a national stage entry under 35 U.S.C. § 371 of PCT patent application no. 99/07935 filed on June 22, 2000, which claims priority to French patent application no. FR99/07935, filed on June 22, 1999. Thus, the priority date of the present application is **June 22, 1999**.

In the present communication, applicants amend the specification to claim priority to French patent application no. FR99/07935 filed June 22, 1999. In addition, applicants provide the PTO with an English language translation of the French patent application no.

FR99/07935 and a declaration by Michel Pernelle that verifies the accuracy of the English language translation.

SEQUENCE RULE

Applicants amend the specification to identify sequences in the legends on figures 6 and 7 and sequences of ICBP90 and ICBP 59 by a respective sequence identification number. Applicants point out that the as-filed specification did identify the sequence in the legend of figure 9 as SEQ ID NO:12, see page 38, lines 23-24.

INFORMATION DISCLOSURE STATEMENT

Applicants submit with the present communication an information disclosure statement and SB-08 form listing references cited in the International Search Report. Applicants note that copies of each listed non-US patent document and each listed non-patent document were submitted to the PTO on May 15, 2002.

OBJECTIONS TO CLAIMS

On separate grounds, the PTO objected claims 3 and 4 for improper language. In the present amendment, applicants cancel claims 3 and 4 without prejudice or disclaimer.

OBJECTIONS TO SPECIFICATION

The PTO objected the layout of the specification for a lack of subtitles/section headings. In the present amendment to the specification, applicants introduce the section headings. Accordingly, applicants request withdrawal of the objection.

REJECTION UNDER 35 U.S.C. § 112, ¶ 2

On separate grounds, the PTO rejected claim 2-4 and claims 3-4 as indefinite. Applicants believe that the revised claims obviate the rejection.

REJECTION UNDER 35 U.S.C. § 101

The PTO rejected claims 1-4 as lacking utility. Applicants respectfully traverse the rejection.

Applicants note that the present invention has a specific, substantially asserted utility as, for example, a diagnostic tool of cancer, see the as-filed application, pages 1, 34-35, 50. In the as-filed specification, applicants have demonstrated that an elevated level of ICBP90 in serum of patients having solid tumors, see figure 8 and a legend to figure 8 on pages 37-38. With this communication, applicants enclose references that further demonstrate the association between ICBP90 and cancer. For example, an enclosed article by Mousli *et. al.* (British Journal of Cancer, v. 89, pp. 120-127, 2003) confirms that ICBP90 expression is altered in cancer cell lines compared to normal cell lines and that cells expressing ICBP90 in breast carcinoma tissues are elevated and follow the grade of the cancer while very few cells express ICBP90 in normal tissues, see abstract and the last paragraph of the first column on page 124. In addition to that, a paper by Unoki *et. al.* (Onkogene, v. 23, 7602-7610, 2004) demonstrates that ICBP90 is accumulated in breast cancer cells (see abstract) and that this protein is involved in cell proliferation, while a document in French by Mousli *et. al.* (Bulletin du Cancer, 89, 5, 505-516, 2002, Article 115) states that anti-ICBP90 can be used not only as a cancer cell marker for better evaluating cancer aggression but also in association with the Mib1 (ICBP90/Ki²67 ratio) as an actual malignancy index (see last two lines). Applicants believe that submitted references clearly support a specific, substantially asserted utility of the present invention as a diagnostic tool of cancer. Accordingly, applicants request withdrawal of the rejection.

REJECTIONS UNDER 35 U.S.C. § 112, ¶ 1, ENABLEMENT

On separate grounds A and B, the PTO rejected claims 1-4 and 2-4 for lack of enablement. Applicants believe that the above argument that the present invention has a specific, substantially asserted utility as a cancer diagnostic tool overcomes the rejection on ground A, see Office Action, page 19. Applicants also believe that the revised claims obviate the rejection on ground B, see Office Action, pages 19-22.

REJECTION UNDER 35 U.S.C. § 112, ¶ 1, WRITTEN DESCRIPTION

The PTO rejected claims 2-4 for lack of written description. Applicants believe that the revised claims obviate the rejection.

REJECTION UNDER 35 U.S.C. § 102(a)

The PTO rejected claims 1-4 as anticipated by Hopfner, R., *et. al.*, Jan 01, 2000, Cancer Research, 60(1): 121-128. The present application claims priority to French patent application no. FR99/07935 filed June 20, 1999, prior to the Hopfner's publication date of January 01, 2000. Accordingly, applicants request withdrawal of the rejection.

REJECTION UNDER 35 U.S.C. § 102(e)

The PTO rejected claim 2 as anticipated by US 6,551,795 or US 6,583,275. In PTO's words, US 6,551,795 discloses SEQ ID NO:20583, which is 100% similar to SEQ ID NO:2 of the instant application, from amino acid 615 to amino acid 623. US 6,583,275 teaches SEQ ID NO:4608, which is 100% similar to SEQ ID NO:2 of the instant application from amino acid 599 to amino acid 606. In the present communication, applicants amend claim 2 to recite "An isolated polypeptide comprising a polypeptide having the sequence aa 263-793 of the amino acid sequence SEQ ID NO. 2." US 6,551,795 and US 6,583,275 disclose only small fragments, 9 and 8 amino acid long respectively, of the polypeptide of the amended claim 2 and, therefore, can not anticipate the polypeptide, "comprising a polypeptide having the sequence aa 263-793 of the amino acid sequence SEQ ID NO. 2." Accordingly, applicants request withdrawal of the rejection.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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